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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,892	04/25/2001	Kazuma Sato	862.C2278	4478

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,892

Applicant(s)

SATO ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) 1-93, 95-99, 101-103 and 105-107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 94, 100 and 104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ① 5/14/04 ② 10/6/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group IV, claims 94, 100 and 104 in the reply filed on 4/28/05 is acknowledged. Claims 94, 100 and 104 are active and are rejected as followed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claim 100 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 94 is directed to a "collection method of collecting used office supplies", which is not within one of the classes of invention set forth in § 101.

The "collection method of collecting used office supplies" comprising the steps of:

a) updating client's collecting data ... ;

b) calculating information ... ; and

c) providing information ... on the incentive", as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "collection method of collecting used office supplies" comprising the steps of a) - c) as shown are merely an abstract ideas and does not reduce to a practical application in the technological arts as the method does not involve with any computer or computing mechanism / network to carry out any functions and that no physical transformation being performed, and are therefore are found to be non-statutory.

See (1) *In re Schrader*, 22 F.3d 290, 30 USPQ2d 1455 (CCPA 1994), (2) *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, (3) *In re Waldbaum*, 173 USPQ 430 (CCPA 1972), (4) *In re Musgrave*, 167 USPQ 280 (CCPA 1970), and (5) *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 100 (method), 94 (apparatus), and 104 (computer program product) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref 1) Applicant Admitted Prior Art (AAPA) in view of (Ref 2) WALKER et al (US Patent 6,567,787) alone or further in view of (Ref 3) ALNWICK (US 2002/0007318) or (Ref 4) STOREY (US Patent 6,009,412).

As for independent method claim 100, (Ref 1) AAPA, as shown under the "Background of the Invention", specification pages 1-3, discloses a collecting method of collecting used items, i.e. office supplies, comprising the steps:

a) collecting client's collecting data (collecting rate) of the items, used office supplies, which is accumulated in a memory for respective clients;

b) calculating information on incentive in compliance with the collecting data above; and

c) providing information (report) to the client by conventional method, which is by mail, wherein the information includes the information on the incentive" {see page 3, line 5}. AAPA fairly teaches the claimed invention except for 2 limitations:

(1) including an "updating" function in the "collection" function of step a), and

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(2) carrying out the providing function of step c) on a displaying device (screen), by which the client orders the items, used office supplies.

In another similar method and apparatus for improving sales of items at point of contact with customer/client, i.e. point-of-sale (POS) terminal, **(Ref 2) WALKER et al**, fairly teaches a step of:

a) collecting client's data (or business transaction such as frequent shopping rating/status of "platinum" based on previous transactions such as (1) amount of money spent, (2) numbers of visits, payments for particular ratings, etc.), in a database {see col. 7, lines 30-44, col. 15, lines 60-67};

b) calculate (determine) information on incentive (discounts, promotional offers) for which the client is eligible based on the collected data updated {see col. 7, lines 5-45, especially line 44 "*determine... discounts or promotional offers .. customer is eligible*"}, and

c) provide the information, promotional offer or incentive, for which the customer is eligible, to the client/customer, thus increasing the chances of the customer's acceptances of such offers, resulting in increase sales and profits {see col. 1, lines 40-55, col. 8, line 65- col. 9, line 10}. As for the further limitation of "updating" function in the "collecting" function of (a), this further limitation is fairly taught on col. 14, lines 41-45, wherein the well known and obvious feature of monitoring data/record, "*updating periodically*" the data for inherent/obvious purpose of obtaining the latest/current record about the client/customer, is mentioned. Therefore, it would have been obvious to apply

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this same further function on the collecting client's data of a) above to collect the latest client's data for accurate evaluation of current status.

Therefore, it would have been obvious to a skilled artisan (businessperson or marketer) at the time the invention was made to modify the manual business practice of (Ref 1) AAPA by converting the practice to automatic practice using computer devices with multiple databases for monitoring customer's purchasing history and providing instant bonuses, rewards to increase potential sales and business revenues at point of sales (POS) {see col. 3, lines 10-22} as taught by (Ref 2) WALKER et al as indicated above. The teachings of AAPA /WALKER et al fairly teaches the claimed invention except for carrying out step (c) or "providing the information" on a screen by which the client order the items. Note that WALKER et al teaches that the information/data including the client's incentive data is automatically and electronically transmitted to the POS terminal and is shown on a display device (computer screen or monitor) to the POS operator {see Fig. 2, (210)} wherein the operator informs (speaks) to the client about the information (message) including the promotional offers and waits for the client's acceptances of the offers (orders) {see col. 7, lines 45-55, col. 8, line 65 to col. 9, line 10}.

Note that WALKER et al also mentions the possibility of the operator (cashier) failing to convey the promotional offers to the client/customer or giving an improper/wrong offers {see col. 1, lines 22, col. 7, lines 45-67}, it would have been obvious to modify the teachings of AAPA /WALKER et al by modifying the last step by allowing the client/customer to see the same information on the same screen or display

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device with the operator/cashier, thus avoiding the problems (possibility) of the operator (cashier) failing to convey the promotional offers to the client/customer or giving an improper/wrong offers as indicated above.

As for the difference in the business service of AAPA (collecting used office supplies and selling new office supplies) and WALKER et al (selling of any goods or services {see col. 3, lines 5-7}), the difference in the type of goods is not important and would have been obvious to a skilled artisan (marketer or businessperson) since the critical issue is making the historical business transaction information (frequent shopper database, Fig. 2) with all of details as shown on col. 7, lines 27-45, Fig. 2 and Fig. 7, available to the salesperson at point of contact with the client/customer so that a promotional offers, for which the customer is eligible, is made to the client/customer for more offering acceptances/sales {see col. 3, lines 15-20}. The inclusion of any other business practice or specific step for a specific application, i.e. collection rate of used office supplies, or exchanged items, etc., which is considered as business practice parameters, would have been obvious to a skilled artisan as mere routine experimentations of business practice parameters {see WALKER et al col. 16, lines 48-55}.

Alternatively, in a method and system for ordering items over the Internet, ALNWICK fairly teaches the steps of tracking client's purchase, calculating information on incentive/awards up-to date based on the client's purchase, and providing the information containing the incentive/awards on a linked page connected to the main web page and displayed on an order screen by which the client can order the items

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{see Figs. 2, 4, 0003, 0005, 0009-0013, 0020, 0100, 0101, 0103}. ALNWICK discloses some of the benefits or ordering process over the Internet such as speed, quickly and instantly on a real time basis and efficient by not calling and traveling to some places to make an order {see [0003, 0005]} or easy access to incentives/bonus data {see Fig. 2 or Fig. 4}. It would have been obvious to a skilled artisan at the time the invention was made to modify the ordering and promotional offers process of AAPA / WALKER et al by using the Internet system as taught by ALNWICK for at least one of the many benefits cited above.

Alternatively, in a method and system for ordering items over the Internet, STOREY fairly teaches the steps of tracking client's purchase, calculating information on incentive/awards up-to date based on the client's purchase, and providing the information containing the incentive/awards on a linked page connected to the main web page and displayed on an order screen by which the client can order the items {see Fig. 1 (40), Fig. 2 (230), (220), (190), col. 1, line 60 - col. 2, line 32, col. 4, lines 1-32, col. 5, lines 45-55, col. 8, lines 10-35}. STOREY discloses some of the benefits or ordering process over the Internet such as speed, quickly and instantly on a real time basis and efficient by not calling and traveling to some places to make an order {see [0003, 0005]} or easy access to incentives/bonus data and instantly redeemable {see advantages on the "Summary of the Invention" or col. 1, line 62 to col. 2, line 32}. It would have been obvious to a skilled artisan at the time the invention was made to modify the ordering and promotional offers process of AAPA / WALKER et al by using

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the Internet system as taught by STOREY for at least one of the many benefits cited above.

8. **As for apparatus claim 94**, which is the respective system containing the respective elements to carry out the respective steps a), b), and c) of independent method claim 100 above, i.e. (a) "an updater" for (a) "updating" function/step, etc. respectively, it's rejected over the respective system to carry out the respective steps as taught by AAPA / WALKER et al alone or further in view of ALNWICK or STOREY above, especially in view of WALKER et al Fig. 2.

As for computer program product claim 104, which is the respective computer program product to carry out the respective steps a), b), and c) of independent method claim 100 above, it's rejected over the respective computer program product to carry out the respective steps as taught by AAPA / WALKER et al alone or further in view of ALNWICK or STOREY above, especially in view of WALKER et al Fig. 2.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 6096094, 1994, discloses an article and device for collecting the article with merits/bonuses given to a user who cooperates with the collection system, similar to the teachings of AAPA cited above. It's cited for applicant's awareness for potential use in the future if needed to avoid citing duplicate rejections.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

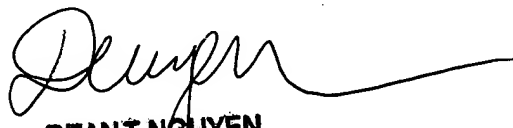
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
July 11, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER